

REMARKS

Claims 8-29 are currently pending in the present application.

The rejection of claims 1 and 3 under 35 U.S.C. § 102(b) over Madsen et al is respectfully traversed.

Applicants submit that Madsen et al fails to disclose a composition having an alkali substance in an amount from 15 to 30 wt. % in combination with Chicago Sky Blue 6B, as presently claimed. Applicants' invention is directed to a composition for staining a microorganism that incorporates an alkali substance at an extremely high concentration, so as to facilitate the staining and detecting of the microorganism. In contrast, Madsen et al discloses a composition having an alkali substance at a relatively low concentration for the purpose of adjusting pH (column 15, lines 42-57, column 16, lines 39-41). Applicants also submit that Madsen et al fails to disclose that the composition also has methanol and/or dimethyl sulfoxide, as presently claimed. In further contradistinction from Applicants' invention, which is also directed to a method of detecting the stained microorganism in the presence of the alkali substance at an extremely high concentration, Madsen et al requires neutralizing the alkali substance prior to detecting the stained microorganism (column 15, lines 42-57, column 16, lines 39-41).

In view of the foregoing, withdrawal of this ground of rejection is respectfully requested.

The rejection of claims 1 and 2 under 35 U.S.C. § 102(b) over Hurley et al is respectfully traversed.

Applicants submit that Hurley et al fails to disclose a composition having an alkali substance in an amount from 15 to 30 wt. % in combination with Chicago Sky Blue 6B

and/or Rhodamine B, as presently claimed. Applicants' invention is directed to a composition for staining a microorganism that incorporates an alkali substance at an extremely high concentration, so as to facilitate the staining and detecting of the microorganism. In contrast, Hurley et al discloses a composition having an alkali substance at a very low concentration of only 5 wt. %, presumably for the purpose of adjusting pH (column 5, lines 21-35). Applicants also submit that Hurley et al fails to disclose that the composition also has methanol and/or dimethyl sulfoxide, as presently claimed.

In view of the foregoing, withdrawal of this ground of rejection is respectfully requested.

The rejection of claims 1 and 2 under 35 U.S.C. § 102(e) over Chae et al is respectfully traversed.

Applicants submit that Chae et al fails to disclose a composition having an alkali substance in an amount from 15 to 30 wt. % in combination with Chicago Sky Blue 6B and/or Rhodamine B, as presently claimed. Applicants' invention is directed to a composition for staining a microorganism that incorporates an alkali substance at an extremely high concentration, so as to facilitate the staining and detecting of the microorganism. In contrast, Chae et al discloses a composition having an alkali substance at an extremely low concentration of only 2.5 mM, presumably for the purpose of adjusting pH ([0200]). Applicants also submit that Chae et al fails to disclose that the composition also has methanol and/or dimethyl sulfoxide, as presently claimed.

In view of the foregoing, withdrawal of this ground of rejection is respectfully requested.

The rejection of claims 1-4 under 35 U.S.C. § 103(a) over Madsen et al in view of Kass and Ostle et al is respectfully traversed.

Unlike Applicants' presently claimed invention, Madsen et al fails to disclose: a composition having an alkali substance in an amount from 15 to 30 wt. % in combination with Chicago Sky Blue 6B for the purpose of facilitating the staining and detecting of a microorganism; that the composition also has methanol and/or dimethyl sulfoxide; and a method of detecting the stained microorganism in the presence of the alkali substance at an extremely high concentration.

Applicants submit that Kass likewise fails to disclose a composition having an alkali substance in an amount from 15 to 30 wt. % in combination with Chicago Sky Blue 6B and/or Rhodamine B, as presently claimed. Applicants' invention is directed to a composition for staining a microorganism that incorporates an alkali substance at an extremely high concentration, so as to facilitate the staining and detecting of the microorganism. In contrast, Kass is completely silent with respect to the incorporation of an alkali substance for facilitating the staining and detecting of a microorganism. Applicants also submit that although Kass discloses staining human cells with Sudan Black B (column 4, lines 19-36), Kass fails to disclose staining microorganisms with Chicago Sky Blue 6B and/or Rhodamine B. Applicants further submit that Kass fails to disclose that the composition also has dimethyl sulfoxide, as presently claimed.

Applicants submit that Ostle et al likewise fails to disclose a composition having an alkali substance in an amount from 15 to 30 wt. % in combination with Chicago Sky Blue 6B and/or Rhodamine B, as presently claimed. Applicants' invention is directed to a composition for staining a microorganism that incorporates an alkali substance at an extremely high concentration, so as to facilitate the staining and detecting of bacterial and fungal microorganisms. In contrast, Ostle et al is completely silent with respect to the

incorporation of an alkali substance for facilitating the staining and detecting of a microorganism. Applicants also submit that although Ostle et al discloses staining prokaryotic bacteria with a composition having Sudan Black B, Ostle et al fails to disclose staining both prokaryotic bacterial and eukaryotic fungal microorganisms with a composition having Chicago Sky Blue 6B and/or Rhodamine B. Applicants further submit that Ostle et al fails to disclose that the composition also has methanol and/or dimethyl sulfoxide, as presently claimed.

The Examiner merely asserts that one of ordinary skill in the art would have immediately recognized that Chicago Sky Blue 6B is a functional equivalent of Sudan Black B for staining prokaryotic bacteria. However, none of the aforementioned cited prior art references actually disclose that Chicago Sky Blue 6B is in fact a functional equivalent of Sudan Black B for staining both prokaryotic bacterial and eukaryotic fungal microorganisms. As a result, Applicants respectfully submit that such a mere assertion, which is unsupported by the disclosure of the prior art references, is based on conjecture and must have therefore been arrived at by utilizing impermissible hindsight reconstruction.

Assuming *arguendo*, that it would have been obvious to one of ordinary skill in the art to substitute Chicago Sky Blue 6B for Sudan Black B for the purpose of staining prokaryotic bacterial and eukaryotic fungal microorganisms, none of the cited prior art references disclose a composition having an alkali substance in an amount from 15 wt. % to 30 wt. % for the purpose of facilitating the staining and detecting of a microorganism, as presently claimed. In addition, none of the cited prior art references disclose detecting the stained microorganism in the presence of the alkali substance at an extremely high concentration. Furthermore, none of the cited prior art references disclose that the composition also has a methanol and dimethyl sulfoxide.

In view of the foregoing, withdrawal of this ground of rejection is respectfully requested.

The Examiner's indication that Applicants have not filed a certified copy of Japanese application 2003-121701 as required by 35 U.S.C. § 119(b) is respectfully traversed.

Applicants submit that the present application is a National Stage (371) application of International patent application PCT/JP04/05085 for which a certified copy of the Japanese application 2003-121701 has previously been submitted. Receipt of the certified copy by the International Bureau in a timely manner under PCT Rule 17.1(a) has been acknowledged as evidenced by the PCT/IB/304, which was filed with the U.S. Patent Office on October 25, 2005.

In view of the foregoing, Applicants respectfully request that the Examiner acknowledge receipt of the certified copy of priority document, Japanese application 2003-121701.

The objection to claims 5-7 for being in improper multiple dependent form is obviated by the cancellation of said claims. In view of the foregoing, withdrawal of this claim objection is respectfully requested.

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In conclusion, Applicants submit that the present application is now in condition for allowance and notification to this effect is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon



Vincent K. Shier
Registration No. 50,552

David P. Stitzel
Registration No. 44,360

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)